

APPENDIX

37 CFR 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

(a)(4) A nonprovisional application, other than for a design patent, or an international application designating the United States of America may claim an invention disclosed in one or more prior-filed provisional applications. In order for an application to claim the benefit of one or more prior-filed provisional applications, each prior-filed provisional application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed provisional application must be entitled to a filing date as set forth in § 1.53(c), and the basic filing fee set forth in § 1.16(d) must be paid within the time period set forth in § 1.53(g). (Emphasis added.)

(5)

(i) Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed provisional applications must contain or be amended to contain a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number).

MPEP 201.11 **>Claiming the< Benefit of an Earlier Filing Date >Under 35 U.S.C. 120 and 119(e)< [R-3]

III. REFERENCE TO PRIOR APPLICATION(S)

B. Reference to Prior Provisional Applications

When the nonprovisional application is entitled to an earlier U.S. effective filing date of one or more provisional applications under 35 U.S.C. 119(e), a statement such as "This application claims the benefit of U.S. Provisional Application No. 60/---, filed ---, and U.S. Provisional Application No. 60/ ---, filed ---." should appear as the first sentence>(s)< of the description or in an application data sheet. In addition, for an application which is claiming the benefit under 35 U.S.C. 120 of a prior application, which in turn claims the benefit of a provisional application under 35 U.S.C. 119(e), a suitable reference would read, **>"This application is a continuation of U.S. Application No. 10/---, filed ---, which claims the benefit of U.S. Provisional Application No. 60/---,

filed ---."<. In the case of design applications, it should appear as set forth in MPEP § 1504.20.

The relationship (i.e., continuation, divisional, or continuation-in-part) is not required and should not be specified when a prior provisional application is being claimed under 35 U.S.C. 119(e). No relationship should be specified because whenever a priority claim to a provisional application under 35 U.S.C. 119(e) is made, it is implicit that the relationship is "nonprovisional application of a provisional application." If a relationship between a prior provisional application and the nonprovisional application is submitted, it may be unclear whether the applicant wishes to claim the benefit of the filing date of the provisional application under 35 U.S.C. 119(e) or 120. Thus, applicants seeking to claim the priority to a provisional application under 35 U.S.C. 119(e) should not state that the application is a "continuation" of a provisional application or that the application claims 35 U.S.C. 120 benefit to a provisional application. Although 35 U.S.C. 120 does not preclude a benefit claim to a provisional application, it is not recommended that applicants claim the benefit to a provisional application under 35 U.S.C. 120 since such a claim could have the effect of reducing the patent term, as the term of a patent issuing from such an application may be measured from the filing date of the provisional application pursuant to 35 U.S.C. 154(a)(2). (emphasis added.)

C. Benefit Claims to Multiple Prior Applications

A nonprovisional application that directly claims the benefit of a provisional application under 35 U.S.C. 119(e) must be filed within 12 months from the filing date of the provisional application.

MPEP 201.04(b) Provisional Application [R-3]

35 U.S.C. 111 Application.

(b) PROVISIONAL APPLICATION.-

(1) AUTHORIZATION.-A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Director. Such application shall include-

- (A) a specification as prescribed by the first paragraph of section 112 of this title; and
- (B) a drawing as prescribed by section 113 of this title.

(2) CLAIM.-A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.

(3) FEE.-

- (A) The application must be accompanied by the fee required by law.
- (B) The fee may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.
- (C) Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee was unavoidable or unintentional.

(4) FILING DATE.-The filing date of a provisional application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

(7) NO RIGHT OF PRIORITY OR BENEFIT OF EARLIEST FILING DATE.-A provisional application shall not be entitled to the right of priority of any other application under section 119 or 365(a) of this title or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c) of this title.

MPEP 201.04(b) further explains that:

A provisional application is not entitled to claim priority benefits based on any other application under 35 U.S.C. 119, 120, 121, or 365. If applicant attempts to claim the benefit of an earlier U.S. or foreign application in a provisional application, the filing receipt will not reflect the improper >benefit or< priority claim. Moreover, if a nonprovisional application claims the benefit of the filing date of a provisional application, and states that the provisional application relies upon the filing date of an earlier application, the claim for >benefit or< priority earlier than the filing date of the provisional application will be disregarded. (emphasis added.)